IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Raith, *et al.*

Serial No.: 10/807,975

Filed: 24 March 2004

For: **Multimedia Message Processing**

Attorney's Docket No: 4740-193

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Patent Pending

Examiner: Mr. Daniel J. Ryman

Group Art Unit: 2616

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REVISED APPEAL BRIEF IN RESPONSE TO NOTICE OF NON-COMPLIANCE

I. REAL PARTY IN INTEREST

The real party in interest is Telefonaktiebolaget L.M. Ericsson.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Applicant's knowledge.

III. STATUS OF CLAIMS

Claim 24 is canceled by previously entered amendment, and claims 1-23 and 25-33 are pending. All pending claims are rejected. The rejection of claims 1-21 and 26-32 is

appealed. The rejection of independent claim 22 and its remaining dependent claims 23 and 25 is not appealed. Further, the rejection of independent claim 33 is not appealed.

IV.   STATUS OF AMENDMENTS

All amendments have been entered.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

The rejected claims under appeal include independent claims 1, 15, 26, 31, and 32. All claims relate to "transcoding" messages outgoing from an originating network to a destination address. As explained in paragraph [0009] of the application:

> A given message may be targeted to a destination network that is compatible with the coding format of multimedia content in the outgoing message, in which case "transcoding" of such content into another coding format is unnecessary. However, the destination network may not be compatible, such as where QCELP audio content in a multimedia message is targeted for delivery to a GSM network subscriber, and in such instances, the exemplary originating network is configured to transcode the incompatible content into a format specified for the destination network. Additionally, or alternatively, the exemplary originating network may be configured to perform transcoding into a default format for certain destination addresses, e.g., transcoding into a format that is widely used in multimedia delivery, such as WINDOWS Media Audio format.

For further reference, paragraph [0029] of the application explains one embodiment of transcoding as "changing the coding format of multimedia content from a current format into one or more new formats."

Independent claim 1

Claim 1 includes the following text:

1. A method of processing multimedia messages outgoing from an originating network comprising:
    selectively transcoding multimedia content in outgoing multimedia
        messages from a current format into a default format as a function of
        their destination network addresses; and
    sending the messages according to their destination network addresses.

Claim 1 selectively transcodes multimedia content into a default format; whether transcoding is applied to a given multimedia depends on the destination network address of that message. Underlying this selective transcoding method is the premise that one or more destination network addresses (or types of addresses) have default coding formats associated with them. Fig. 1 depicts a multimedia messaging center 12 that in one or more embodiments is configured to carry out the method of claim 1. Correspondingly, Fig. 2 depicts one embodiment of the method of claim 1.

A detailed description of Fig. 2 begins at paragraph [0044], where treatment of a given outgoing multimedia message is described. In particular, paragraph [0045] explains that the destination network address of the message is evaluated to determine whether default transcoding is desired (Step 102 of Fig. 2). If default transcoding is desired, a multimedia server 16 in the multimedia message center 12 initiates or performs the transcoding, wherein one or more multimedia components of the message are transcoded from their current format(s) into the default format(s) (Step 106 of Fig. 2). Notably, Fig. 2 illustrates and paragraph [0046] correspondingly explains that, if default transcoding is not desired for the outgoing message, processing may continue with determining whether any specific transcoding is desired for the outgoing message (Step 110 of Fig. 2). If specific transcoding is desired, the server 16 accesses information that indicates the specific coding format(s) to use, and transcoding into the specific format(s) is carried out.

As paragraph [0048] explains, "[t]he benefit of default transcoding derives from the conversion of particular portions of the multimedia content from coding formats that may be native to the originating network, but that may not be widely used outside of similar types of networks." As an example, the same paragraph explains that the server 16 may be configured to use encoding formats that are generally used for Internet multimedia as "default" coding formats for outgoing messages targeted to Internet domain addresses, e.g., email addresses.

One skilled in the art will recognize this approach as an advantageous approach to changing multimedia coding from a format that may be less commonly used to a format that is widely used (at least for the type of network associated with the message recipient).

Thus, claim 1 can be understood to provide transcoding of multimedia content from a current format into a default format for a given outgoing message, if the destination address of that message is associated with default coding format information. The default coding format(s) are advantageous because they are known to be generally compatible with the type of equipment and processing most commonly associated with the destination network. Of course, as paragraphs [0049] and [0050] explain, given destination network addresses or domains may have specific coding formats specified for them. In those cases, the specific coding formats are used.

Independent claim 15

Claim 15 in its entirety includes the following text:

15. A method of processing multimedia messages outgoing from an originating network comprising:
    sending destination address information for an outgoing multimedia
        message from a first entity to a second entity;
    receiving at the first entity a corresponding indication from the second
        entity as to whether multimedia content transcoding is desired for the
        message;
    selectively performing transcoding at the first entity based on the
        indication; and
    sending the message from the first entity for delivery to the destination
        address.

In a supporting example related to claim 15, Fig. 2 in the application illustrates a "supporting entity 20," which is properly understood as an example of the claimed second entity. Correspondingly, the multimedia message center 12, and, particularly, the multimedia server 16 shown in Fig. 2, is properly understood as an example of the claimed first entity.

Summary paragraph [0012] in the application explains that the second entity is a database server, for example, that is configured to determine whether transcoding should or

should not be performed for a given outgoing multimedia message. Fig. 3 in the application depicts an example embodiment of processing logic implementing the method of claim 15. According to the corresponding description in paragraphs [0051]-[0053], the server 16 cooperates with the supporting entity 20 by sending destination address information for a given outgoing message to the supporting entity 20 (Step 122 in Fig. 3), which determines whether transcoding is desired for the outgoing message and returns a corresponding indication to the server 16 (Step 124 in Fig. 3).

Paragraph [0058] explains that one advantage of such an arrangement is that the network operator of the multimedia messaging center 12 (and server 16) is not necessarily obligated to maintain the supporting entity 20. In other words, a third-party entity can be responsible for maintaining a database of information that indicates whether (and what type of) transcoding is desired for different network destination addresses. In this manner, the third-party operator shoulders the burden of maintaining and updating the database for use by the multimedia messaging centers of one or more network operators.

Independent claim 26

Claim 26 in its entirety includes the following text:

26. A method of processing multimedia messages outgoing from an originating network comprising:

identifying a destination address of an outgoing multimedia message;

selectively performing default transcoding of multimedia content in the message based on identifying the destination address as one for which default transcoding is indicated;

selectively performing specified transcoding of multimedia content in the message based on identifying the destination address as one for which specified transcoding is indicated; and

sending the message for delivery to the destination address.

Claim 26 can thus be understood as being like claim 1, except that it includes the further limitation of selectively performing specified transcoding based on identifying that the destination address of an outgoing multimedia message is one for which specific transcoding is indicated. One skilled in the art will thus understand claim 26 as covering three cases: (1) no transcoding in the case that a message's destination address has no default transcoding or specific transcoding associated with it; (2) default transcoding in the case that the message's destination address has default transcoding indicated for it; and (3) specific transcoding in the case that the message's address has specific transcoding indicated for it. Paragraph [0035], for example, explains that the multimedia message center 12 may be equipped with a table that lists formats not supported by particular networks, or that identifies formats specifically desired by particular destination networks.

One sees in Fig. 1 an example of the processing in claim 26, and paragraphs [0045]-[0047] provide a corresponding description. Step 104 in Fig. 2 evaluates whether default transcoding is indicated for the destination network address of a given outgoing multimedia message. "Yes" from Step 104 leads to the performance of default transcoding (Step 106), which involves transcoding multimedia content into a generally compatible format. "No" from Step 106 leads to determination of whether specific transcoding is desired (Step 110). If so, specific transcoding is performed.

Independent claim 31

Claim 31 in its entirety includes the following text:

> 31. A multimedia message center for processing multimedia messages outgoing from an originating network comprising a server configured to selectively transcode multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses, and send the messages according to their destination network addresses.

Claim 31 finds support in the application at paragraph [0019], for example, which describes the multimedia message center 12 of Fig. 1. That paragraph describes a server 16 that includes a circuit or system 18 that is configured to support selective transcoding of multimedia content of outgoing messages. More details regarding the selective default transcoding are shown in Fig. 2, where the processing steps of Fig. 2, including selective default transcoding, are described in detail at paragraphs [0045]-[0047].

Independent claim 32

Claim 32 in its entirety includes the following text:

> 32. A multimedia message center for processing multimedia messages outgoing from an originating network comprising:
> a multimedia server configured to send destination address information for an outgoing multimedia message to a database server, and to receive an indication back from the database server as to whether multimedia content transcoding is desired for the message;
> said multimedia server comprising a first circuit configured selectively to perform transcoding based on the indication, and a second circuit configured to send the message for delivery to the destination address.

Claim 32 can be understood as being an apparatus claim directed to the same or substantially the same subject matter as method claim 15. Fig. 1 depicts a multimedia messaging server 12 that includes a multimedia server 16. The server 16 includes a transcoding circuit 18 that is described at paragraph [0019] as being configured to support selective transcoding of outgoing multimedia messages. Paragraph [0019] also explains that the server

16 may cooperate with a database server (e.g., entity 20 in Fig. 1). Paragraph [0013] details the first and second circuits of the server 16, while paragraphs [0051]-[0053] explain the processing details depicted in Fig. 3, which illustrate the server 16 sending destination network addresses for outgoing multimedia messages to the supporting entity 20 (a database server), which correspondingly returns indications of whether default transcoding is desired.

GROUNDS OF REJECTION

Claims 1-14 and 26-30 are rejected as being indefinite under 35 U.S.C. §112, second paragraph.

Claims 1-4, 9-13, 15, 16, 18-20, 31, and 32 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pub. 2004/0111476 to Trossen et al. (hereinafter referred to as "Trossen").

Claims 5-8, 17, and 21 are rejected under 35 U.S.C. § 103(a) as being obvious over Trossen.

ARGUMENT

All rejections on appeal critically depend on the examiner's argument at lines 17-18 on p. 3 of the first Office Action ("OA" mailed on 30 Oct. 2007) that the Webster's Collegiate Dictionary defines the word "default" to mean "in the absence of." In actuality, "in the absence of" is not the dictionary definition given for the word "default" but rather is the definition given for the phrase "in default of." In its initial reply (mailed 29 Jan. 2008), Applicant pointed out to the examiner that he was using the dictionary definition given for the phrase "in default of," and pointed out that the dictionary definition given for the word "default" was different.

Specifically, the reply of 29 Jan. 2008 referred the examiner to the Merriam-Webster Dictionary (available online at www.m-w.com), which defines that the word "default" means "a selection made usually automatically or without active consideration due to a lack of a viable alternative," or "a selection automatically used by a computer program in the absence of a choice made by a user." By improperly substituting the dictionary definition of the phrase "in default of" for the word "default," the examiner has illegally misconstrued the claims, which use the word "default" as a modifier in the phrase "default format."

For example, the first OA explicitly states that (all) rejections made in view of the prior art are based on construing the claim term "default format" to mean "...any format specified by the destination address." (Emphasis added.) That construction results in an impermissibly overbroad and unreasonable claim construction that is at odds with the specification, and is at odds with the claim term meanings that would be given by one of ordinary skill in the art, upon reading the specification.

The improper claim term construction is further evidenced by the final OA argument at the bottom of p. 2, which states that "for the claimed term 'default format' to have any meaning, there must be an alternative to the 'default format' that can be selected in most situations." (Emphasis added.) The examiner continues by stating that "[f]or example, in the context of the claim, the term "default format" would be properly applied to a format that is selected when there is no format specified for the destination network address, where a format is specified for most destination network addresses." The examiner concludes by stating that "...no such structure is ever presented in applicant's claim."

These statements are demonstrably wrong and they overlook the fact that multimedia content in a given outgoing multimedia message is already encoded into one or more current formats, e.g., a current audio encoding format, a current video encoding format, etc. Thus, in all claims, one option is to perform no transcoding at all, and instead simply send the message "as

is," based on its current encoding formats. This processing capitalizes on the idea that some destination network addresses, e.g., Internet email addresses, are known to be generally compatible with certain coding formats, and the claims are directed to methods and apparatuses that perform default transcoding where default formats are indicated for given destination network addresses or types of addresses.

Further, it is important to note that at least claims 1, 26 and 31 stipulate selective transcoding into a default format, or otherwise make clear that transcoding into a default format is a conditional operation. In claim 1, for example, default format transcoding is (or is not) applied as a function of the message's destination network address.

One skilled in the art would understand from the explicit claim language that any given destination network address may be associated with no coding preferences, in which case the message is not transcoded at all and is simply sent in its current coding format(s). On the other hand, a given destination network address may be associated with specified coding formats, in which case, the multimedia content in an outgoing message targeted to that address is transcoded according to the specified formats. Still further, one skilled in the art would understand that a given destination network address may not have had any specific coding formats specified for it, but nonetheless it may be known that one or more coding formats generally are compatible with the type of network that the destination address is associated with. In this case, transcoding into the default format(s) makes it much more likely that the outgoing message will be compatible with the destination network equipment.

Fig. 2, paragraphs [0045]-[0047] and paragraph [0060] illustrate the above three cases. Applicant points out that particular alternative embodiments and further processing details are captured in the flow diagrams of Figs. 3-5, which are understood as relating to particular implementation details for the overall processing of Fig. 2.

Applicant appreciates that, during examination, claims terms are to be given their broadest reasonable interpretation consistent with the specification. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364, 70 U.S.P.Q.2d 1827 (Fed. Cir. 2004) (quoting *In re Bond*, 910 F.2d 831, 833, 15 U.S.P.Q. 1566 (Fed. Cir. 1990). However, the construction given to claim terms must take into account any definitions presented in the specification. *In re Cortright*, 165 F.3d 1353, 1358, 49 U.S.P.Q.2nd 1464 (Fed. Cir. 1999). Further, the construction given to claim terms for purposes of examination also must be consistent with the construction that would be given by one of ordinary skill in the art. *American* at 1364.

The evidentiary record is clear that (1) the examiner began examination by incorrectly substituting the meaning of the phrase "in default of" for the claim term "default" as applied in the phrase "default format." The dictionary definitions made of record by Applicant make the examiner's mistake clear. Rather than reevaluate the prior-art based rejections in view of Applicant's rebuttal arguments, the examiner made all anticipation and obviousness rejections final, and advanced the understanding that "default format" was indefinite, based on stating that "for the claimed term 'default format' to have any meaning, there must be an alternative to the 'default format' that can be selected in most situations," and that no claims set forth this structure.

All claims and the application make clear that outgoing message processing begins with the given outgoing message already being encoded in one or more current formats and that transcoding is selectively applied. (It may be that no transcoding is performed.) Some of the claims at issue include the limitation that transcoding into a specific format may also be performed selectively. It is helpful to note that paragraph [0060] of the application states that:

> As before, the <u>distinction between transcoding and not transcoding can be based on determining whether the destination address is identified as belonging to a set of addresses for which transcoding is desired</u>. Furthermore, it may similarly be determined whether, if transcoding is desired, whether the <u>destination address is identified as belonging to a set of addresses for which specific transcoding formats are desired</u>. Again, this may comprise <u>determining whether the targeted</u>

<u>address corresponds to some Internet domain, e.g., default coding, or whether it</u>
<u>corresponds to a different type of wireless network, e.g., specific coding</u>.

(Emphasis added.)

Applicant respectfully submits that the evidence of record demonstrates that the claims

have been misconstrued, and that the misconstruction is impermissible as being overbroad,

unreasonable, and at odds with the specification. For at least this reason, all rejections should

be withdrawn.

The Indefiniteness Rejections

Claims 1-14 and 26-30 are not indefinite under the appropriate legal analysis. All

indefiniteness arguments rest on the allegation that the Applicant has (1) acted as his own

lexicographer by using "default" to mean something different than its dictionary definition; and

(2) failed to clearly redefine the word in the specification. That latter argument perhaps means

that the examiner believes that the claims fail to use the word "default" in a manner that is

consistent with respect to any of its understood meanings. See Item 21 on p. 10 of the final OA.

More particularly, the examiner states in Item 21 that "[t]he term 'default' in claims 1 and

26 is used by the claim to mean 'a particular format specified for a particular destination

address', while the accepted meaning is 'in the absence of,' Webster's Collegiate Dictionary."

Applicant has already pointed out that the accepted meaning of "default" is not "in the absence

of" and the dictionary supports Applicant on this point and contradicts the examiner—see, e.g.,

http://www.m-w.com, as maintained for the online version of the Merriam-Webster Dictionary.

Moreover, saying that default format means a "particular format specified for a particular

destination address" overlooks not only the plain language of the claims, but the plain language

of the specification. For example, paragraph [0009] teaches that:

> ...[t]he destination network may not be compatible, such as where QCELP audio
> content in a multimedia message is targeted for delivery to a GSM network
> subscriber, and in such instances, the exemplary originating network is

> configured to <u>transcode the incompatible content into a format specified for the destination network</u>. <u>Additionally, or alternatively,</u> the exemplary originating network may be configured <u>to perform transcoding into a default format for certain destination addresses, e.g., transcoding into a format that is widely used in multimedia delivery, such as WINDOWS Media Audio format</u>.

(Emphasis added.)

The application thus teaches that a particular coding format specified for a particular destination network address is denominated as a "specific format," while a coding format known or likely to be compatible with a given destination network address is a default format for that address (and others in the same network domain). Fig. 2 and paragraphs [0045]-[0047] further illustrate the difference between selectively transcoding into specified formats versus selectively transcoding into default formats. Those skilled in the art will appreciate that it may be much easier simply to maintain information about default formats that are known to be or are likely to be compatible with various types of destination networks, as compared to maintaining specific format information for all destination networks.

Still further, the examiner's arguments that "default" has to mean "in the absence of" take an impermissibly narrow view. For example, one skilled in the art will immediately understand from the claims that an outgoing message retains its "current format" for multimedia encoding in the absence of any indication that default format (or specific format) transcoding should be performed. All flow diagrams illustrate this selective processing, and differentiate between cases where no transcoding is performed, where default format transcoding is performed, and where specified format transcoding is performed. Again, see Steps 104/106 and Steps 110/112 of Fig. 2, paragraphs [0045]-[0047] and paragraph [0060]of the application. See also, elements 154A and 154B of Fig. 5, which expressly depicts different processing paths for default transcoding versus specific transcoding.

The examiner commits further error in Item 16 of the final OA, by stating that it is inappropriate for the examiner to read "exemplifications" from the specification into the claim

terms at issue, because Applicant failed to explicitly define the terms "default" and "specific" in the application. Applicant submits that the application amply defines those terms, such as in paragraph [0009], in paragraphs [0045]-[0047], in at least Figs. 3 and 5, and further in paragraph [0060].

As the Board recently stated, the proper focus during claims examination for determination of definiteness is whether the claims meet the threshold requirements for clarity and precision (and not whether other modes of expression are available). *Ex Parte David Tester*, 2008 WL 4359777 (Bd.Pat.App. & Interf, 23 Sep. 2008). More particularly, 35 U.S.C. § 112, second paragraph requires that the claims of a patent must "particularly point out and distinctly claim the subject matter which the applicant regards as his invention." In view of this requirement, a claim is properly considered indefinite if it does not reasonably apprise those skilled in the art of its scope. *Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 520 F.3d 1367, 1374, 86 U.S.P.Q.2d 1225 (Fed. Cir. 2008) (citing *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1383, 77 U.S.P.Q.2d 1140 (Fed. Cir. 2005)).

Still further, Section 2173 of the MPEP sets for the test for claim indefiniteness under 35 U.S.C. § 112, second paragraph, as whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." (Citing to *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)). Applicant submits that its use of the term "default" in the rejected claims is abundantly clear to those skilled in the art, in view of the specification.

The Anticipation Rejections

Claims 1-4, 9-13, 15, 16, 18-20, 31, and 32 are rejected as being anticipated by Trossen. The allegedly anticipated claims include independent claims 1, 15, 31 and 32.

Under the controlling law, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987). The determination of anticipation requires comparing a properly interpreted claim to the prior art. Id.

For such determination, "words in claims are generally given their ordinary and customary meaning to a person of ordinary skill in the art at the time of the invention." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-1313, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005) (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 U.S.P.Q.2d 1573 (Fed. Cir. 1996)). However, "it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." Id. at 1316, quoting *United States v. Adams*, 383 U.S. 39, 49, 86 S.Ct. 708, 15 L.Ed.2d 572 (1966).

Under the proper anticipation analysis, it is clear that Trossen does not teach selectively performing default transcoding, nor does the examiner suggest that it does in any real sense. Instead, the examiner explicitly predicates the Trossen-based rejections on the statement that default format means any format specified for a destination address.

In reality, Trossen includes little or no detail regarding its manner of transcoding. Trossen does focus on "recipient rules," which are typically specified by recipients. See Trossen at paragraph [0030]. These recipient rules generally relate to connectivity, such as stipulating that multimedia messages are to be delivered to a given recipient only when a particular type of network connection is available, or are to be delivered only from specific senders. See Trossen at paragraphs [0032] and [0033]. This can be understood as a given user making a rule that multimedia messages not be delivered to his or her equipment, unless the user has a given type of network connection (e.g., a high-bandwidth connection).

Paragraph [0034] in Trossen explicitly identifies that transcoding can be expressly stipulated by a recipient in a recipient rule. However, this paragraph, along with similar but less detailed teachings in the Abstract and paragraph [0008], are the only discussion of transcoding in the entirety of Trossen's specification. At most, Trossen stands for the proposition that a given user (standing as a potential recipient of multimedia messages) can define a recipient rule to control how, when, and in what format those messages are delivered.

One can argue that Trossen's recipient transcoding rules are like or quite similar to the "specified formats" in the application. Consequently, one cannot simultaneously argue that they are also like the claimed default formats.

Regarding claims 1-4, 9-13, and 31

Claim 1 stipulates selectively transcoding multimedia content into outgoing multimedia messages from a current format into a default format as a function of their destination network addresses. In contrast, Trossen teaches that individual message recipients can define recipient rules, and that a given recipient rule can specify transcoding. That can only be understood as a specific transcoding format with respect to Applicant's claims and application.

For example, claim 2 stipulates that default transcoding is applied to messages targeted to email addresses, and claim 3 stipulates that default transcoding is not performed for messages not targeted to email addresses. Trossen literally says nothing about performing or not performing a default transcoding based on whether or not given messages are targeted to email addresses.

The examiner mistakenly relies on paragraphs [0002] and [0065]-[0067] of Trossen to support the rejection of claim 2, and on paragraphs [0035] and [0036] to support the rejection of claim 3. Tellingly, while those portions of Trossen describe that multimedia messaging can involve mobile users and the Internet (such as email), none of the sections cited by the

examiner teach or even allude to the idea of applying a default transcoding to multimedia messages that are targeted to email addresses. Again, to the extent that Trossen (barely) mentions transcoding, it does so with the teaching that particular recipient rules can specify transcoding.

The examiner admits as much in the anticipation rejection of claim 4, wherein he states that paragraphs [0034] and [0036] of Trossen teach that recipient rules can define multimedia content transcoding, and that recipient rules are associated with recipient addresses. Trossen indeed does seem to teach that particular recipients can define recipient rules that stipulate transcoding for messages targeted to them. However, claim 1 claims selectively performing default transcoding, while dependent claim 4 claims performing specific transcoding. Together, claims 1 and 4 must be understood as claiming that both default and specific format transcoding is performed, on a selective basis as a function of destination addresses. Again, the rejection makes no attempt to reconcile the absence of default format transcoding in Trossen.

Similarly, claim 10 claims that selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses comprises, with regard to claim 1, performing default transcoding for outgoing messages targeted to Internet domains and not performing default transcoding for outgoing messages targeted to wireless network domains. Trossen teaches no more than that one or more recipients (users) can, if they like, specify that transcoding be used for messages targeted to them. Trossen presents no teachings relevant to performing default format transcoding to messages outgoing to Internet domains, and not doing so for messages outgoing to wireless network domains. Indeed, the slight mention that Trossen gives to transcoding suggests only that a specific transcoding be used, where a particular recipient rule stipulates it.

As such, Trossen as a matter of law does not anticipate dependent claims 11-13, which depend from claim 12, and adds further limitations directed to the specific format transcoding of messages outgoing to wireless network domains.

Further, independent claim 31 is an apparatus claim directed to subject matter similar to that in independent method claim 1. The examiner rejects claims 1 and 31 on the same basis. Claim 31 is not anticipated for at least the reasons given for claim 1.

Regarding claims 15, 16, 18-20, and 32

Claim 15 also stipulates selective transcoding, but wherein selective transcoding (default or otherwise) is applied by a first entity based on sending a message's destination address information to a second entity, which returns a corresponding indication as to whether transcoding is desired. The first entity selectively performs transcoding based on the returned indication.

Trossen does teach a rules processor 170 that determines whether to perform transcoding for a message and states that the rules processor can be part of a multimedia messaging center, or separate from the center. See Trossen at paragraph [0024]. However, only paragraph [0034] of Trossen explicitly mentions anything regarding actual transcoding, and that description describes the rule processor 170 as being a self-contained decision maker, e.g., it evaluates any recipient rule that might be associated with an outgoing message and applies any specified transcoding. There does not appear anywhere in Trossen the explicitly claimed first entity/second entity arrangement, where the first entity provides destination address information to a second entity, which determines whether transcoding is desired based on the address (not based on a recipient rule), and returns an indication as such to the first entity.

The examiner refers to user databases, etc., and appears to be suggesting that claim 15 is somehow inherent in Trossen. That line of argument is insufficient to meet the legal burden for establishing a *prima facie* case of anticipation, and is not consistent with the drawings in

Trossen. For example, Fig. 3 appears to show in line 310 that Trossen's multimedia server passes messages to the rule processor 170 for processing according to recipient rules. The rule processor 170 is not depicted as receiving destination address information and correspondingly returning indications of whether transcoding is desired.

Dependent claim 16 adds the further limitation that the second entity of claim 15 is external to the originating network. Trossen evidently knows to distinguish external entities from internal (intra-network) entities, and does so for external email server 134 in Fig. 1. Trossen does not disclose that its rule processor 170 is external, and the functionality of the rule processor does not, in any case, match that claimed in claim 15. Claim 16 therefore is not anticipated by Trossen.

Further, independent apparatus claim 32 claims subject matter similar to that claimed in independent method claim 15. Applicant submits that claim 32 is not anticipated by Trossen for at least the reasons given for claim 15.

Further, claim 32 in detail claims a multimedia message center for processing multimedia messages outgoing from an originating network. The claimed messaging center includes a multimedia server configured to send destination address information for an outgoing multimedia message to a database server, and to receive an indication back from the database server as to whether multimedia content transcoding is desired for the message. Trossen does not disclose this claimed arrangement, and cannot anticipate claim 32

Instead, Trossen discloses a rule processor 170—see paragraph [0024] and [0034] of Trossen, along with Figs. 1, 2, and 3 of Trossen. Trossen never discloses that anything other than its rule processor 170 applies transcoding. Paragraph [0009] generically discusses a network entity that does transcoding, but this appears to relate to Trossen's notion that the rule processor can be inside of a multimedia messaging center. Paragraph [0034] explicitly

associates transcoding with the rule processor 170, but that explanation makes clear that the rule processor 170 makes transcoding decisions and performs transcoding.

Applicant can find no illustration or description in Trossen that teaches a multimedia server that sends destination address information for an outgoing multimedia message to a database server and correspondingly receives back an indication as to whether transcoding is desired, and then selectively transcodes based on that indication. This arrangement is described in the specification as an advantageous implementation that allows a third-party database to control transcoding, based on communications with a given network's multimedia messaging center. Trossen does not appear to teach or suggest this arrangement.

The Obviousness Rejections

Claims 5-8, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trossen. All such claims are non-obvious at least because their respective base claims are not anticipated by Trossen.

Further, regarding claims 5-8, these claims depend from claim 4, which depends from claim 1. Claim 4 adds to claim 1 the limitation of selectively transcoding multimedia content in one or more outgoing messages into specified formats as a function of their destination addresses. Claim 5 narrows this limitation by stipulating that selective specified format transcoding comprises recognizing that an outgoing message is targeted to a wireless network domain, and correspondingly applying a transcoding format specified for that domain to multimedia content in the message. Claims 6-8 add further limitations.

The examiner states that Trossen "does not expressly disclose that the particular address is related to a particular wireless network domain." However, the examiner argues that claim 5 is obvious based on Trossen's teachings of "specifying a particular type of message be delivered over a particular type of network (¶ [0046], where a rule can be defined that requires

media content to be delivered over a given type of network, and where the networks are wireless networks), where the type of network may require a specific format for delivery (¶[0047], where the network may require transcoding).

This line of obviousness rejection does not bring in any consideration that claim 1 includes a limitation of selective default format transcoding, such that the limitation in claim 5 of specified format transcoding for wireless network domains must be understood as something performed instead of or as an alternative to default transcoding, on the basis of recognizing that the destination of a given message is a wireless network domain (instead of, e.g., an Internet domain). At most, Trossen teaches specific transcoding for messages to which a specific rule applies.

The question of obviousness is resolved on the basis of underlying determinations of fact, including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.,* 383 U.S. 1, 17-18 (1966).

The examiner has not carried the legal burden of establishing a *prima facie* case for obviousness particularly regarding claims 5-8, not least because of errors regarding the first and second prongs of the Graham analysis. Namely, the examiner errs when alleging that Trossen teaches the default decoding limitation of claim 1. This error results in an incorrect comparison of the limitations in claims 5-8 with the teachings of Trossen. Applicant submits that the examiner has failed to establish a *prima facie* case for the obviousness of claims 5-8 in view of these factual records.

Regarding claims 26-30

Claim 26 is a method claim that stipulates selectively performing default transcoding of multimedia content in a message based on identifying its destination address as one for which default transcoding is indicated, and selectively performing specified transcoding of multimedia

content in a message based on identifying its destination address as one for which specified transcoding is indicated. Default transcoding relates to an encoding format that is generally compatible with a given network domain or type, while specified transcoding relates to an encoding format that has been explicitly associated with a given destination network address or addresses. See, for example, paragraph [0060] and elements 5A and 5B of the application; also, see paragraphs [0010] and [0045]-[0047].

Given the clear understanding of the terms at issue in claims 26-30, Applicant submits that excluding these claims from examination as being indefinite was improper. Applicant further submits that Trossen demonstrably does not teach a method where default transcoding and specified transcoding are respectively applied on a selective basis.

CLAIMS APPENDIX

The following claims are on appeal:

1.   A method of processing multimedia messages outgoing from an originating network comprising:

> selectively transcoding multimedia content in outgoing multimedia messages from a
>> current format into a default format as a function of their destination network
>> addresses; and
>
> sending the messages according to their destination network addresses.

2.   The method of claim 1, wherein selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses comprises performing transcoding for messages targeted to email addresses.

3.   The method of claim 1, wherein selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses comprises not performing transcoding for messages not targeted to email addresses.

4.   The method of claim 1, further comprising selectively transcoding multimedia content in outgoing multimedia messages from a current format into one or more specified formats as a function of their destination network addresses.

5.   The method of claim 4, wherein selectively transcoding multimedia content in outgoing multimedia messages from a current format into one or more specified formats as a function of

their destination network addresses comprises determining that an outgoing message is targeted to a wireless network domain, and transcoding at least a portion of the multimedia content in the message into a format specified for the targeted wireless network domain.

6.   The method of claim 5, wherein determining that an outgoing message is targeted to a wireless network domain comprises identifying a targeted mobile telephone number for the outgoing message and identifying a name of the wireless network domain based on accessing an ENUM database that associates mobile station telephone numbers with particular wireless network domains.

7.   The method of claim 5, wherein selectively transcoding multimedia content in outgoing multimedia messages from a current format into one or more specified formats as a function of their destination network addresses comprises transcoding audio content in the outgoing message from a first audio coding format associated with the originating communication network into a second audio coding format specified for the targeted wireless network domain.

8.   The method of claim 7, wherein the originating network comprises either a GSM wireless communication network, or a cdma2000 wireless communication network, and the targeted wireless network domain corresponds either to a GSM wireless communication network, or to a cdma2000 wireless communication network.

9.   The method of claim 1, wherein the originating network comprises a first wireless communication network, and wherein sending the messages according to their destination network addresses comprises sending the messages from one or more Multimedia Messaging Services (MMS) servers in the first wireless communication network.

10. The method of claim 1, wherein selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses comprises performing default transcoding for outgoing messages targeted to Internet domains and not performing default transcoding for outgoing messages targeted to wireless network domains.

11. The method of claim 10, further comprising, for outgoing messages targeted to wireless network domains, determining whether transcoding is desired for a particular outgoing message targeted to a particular wireless network domain, and, if so, transcoding at least a portion of the multimedia content in that message into a format specified for that particular wireless network domain.

12. The method of claim 11, wherein determining whether transcoding is desired for a particular outgoing message targeted to a particular wireless network domain comprises determining whether a database identifies that particular network as one for which transcoding is desired.

13. The method of claim 12, further comprising identifying from information stored in the database the format specified for that particular network.

14. The method of claim 1, wherein selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses comprises, for a particular outgoing message, determining whether default transcoding is desired based on the destination network address of that

message, and if default transcoding is not desired, determining whether specified transcoding is desired based on determining whether a domain database indicates that specified transcoding is desired for the destination network address of that message.

15.   A method of processing multimedia messages outgoing from an originating network comprising:

      sending destination address information for an outgoing multimedia message from a first

           entity to a second entity;

      receiving at the first entity a corresponding indication from the second entity as to

           whether multimedia content transcoding is desired for the message;

      selectively performing transcoding at the first entity based on the indication; and

      sending the message from the first entity for delivery to the destination address.

16.   The method of claim 15, wherein the second entity is external to the originating network.

17.   The method of claim 15, wherein sending destination address information for an outgoing multimedia message from a first entity to a second entity comprises forwarding the message from the first entity to the second entity, and wherein the message includes the destination address information.

18.   The method of claim 15, wherein the originating network comprises a first wireless communication network, and wherein sending destination address information for an outgoing multimedia message from a first entity to a second entity comprises sending an indication of a destination mobile telephone number targeted by the message, or sending an indication of a destination network domain targeted by the message.

19.   The method of claim 15, wherein receiving from the first entity a corresponding indication

from the second entity as to whether multimedia content transcoding is desired for the message

comprises receiving an indication from the second entity that identifies a desired format for

transcoding at least a portion of the multimedia content in the message.

20.   The method of claim 19, wherein selectively performing transcoding at the first entity

based on the indication comprises determining whether the corresponding indication returned

by the second entity indicates that transcoding is desired and, if so, transcoding at least a

portion of the multimedia content in the message into the desired format.

21.   The method of claim 15, wherein sending the message from the first entity for delivery to

the destination address comprises sending the message to a multimedia server in a destination

network for subsequent delivery to a targeted recipient.

26.   A method of processing multimedia messages outgoing from an originating network

comprising:

    identifying a destination address of an outgoing multimedia message;

    selectively performing default transcoding of multimedia content in the message based

        on identifying the destination address as one for which default transcoding is

        indicated;

    selectively performing specified transcoding of multimedia content in the message based

        on identifying the destination address as one for which specified transcoding is

        indicated; and

    sending the message for delivery to the destination address.

27.   The method of claim 26, wherein sending the message for delivery to the destination

address comprises sending the message to a multimedia server in a destination network for

delivery by that multimedia server to a targeted recipient of the message.

28.   The method of claim 26, wherein identifying the destination address as one for which

default transcoding is indicated comprises recognizing that the destination address corresponds

to an Internet email address.

29.   The method of claim 26, wherein identifying the destination address as one for which

specified transcoding is indicated comprises recognizing that the destination address

corresponds to a wireless communication network for which transcoding is desired.

30.   The method of claim 29, further comprising transcoding at least a portion of the

multimedia content in the message from a current coding format into a specified coding format,

and wherein the specified coding format is indicated for the destination address.

31.   A multimedia message center for processing multimedia messages outgoing from an

originating network comprising a server configured to selectively transcode multimedia content

in outgoing multimedia messages from a current format into a default format as a function of

their destination network addresses, and send the messages according to their destination

network addresses.

32.   A multimedia message center for processing multimedia messages outgoing from an

originating network comprising:

      a multimedia server configured to send destination address information for an outgoing

            multimedia message to a database server, and to receive an indication back from

            the database server as to whether multimedia content transcoding is desired for

            the message;

      said multimedia server comprising a first circuit configured selectively to perform

            transcoding based on the indication, and a second circuit configured to send the

            message for delivery to the destination address.

IX.   EVIDENCE APPENDIX

None.

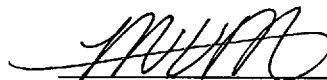## X.   RELATED PROCEEDINGS APPENDIX

None.

XI. CONCLUSION

All rejections depend on the examiner's finding that "default format" is either indefinite and/or properly construed for purposes of claim construction to mean any particular format specified for any particular message address. On the other hand, Applicant believes that the claims and application provide for a clear understanding of the word "default" and the phrase "default format", and all claims alleged as indefinite therefore are definite and, when properly construed, patentably define over Trossen.

Applicant believes that is particularly significant that the definition used by the examiner is the dictionary definition given for the phrase "in default of," rather than the dictionary definition given for the word "default". When the word default is given its ordinary meaning, use of that word in the claims and in the specification would be clearly understood by one of ordinary skill in the art.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

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